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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,086	10/24/2001	Avi J. Ashkenazi	GNE.2630P1C64	4093
35489	7590	06/13/2005		
HELLER EHRMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506			EXAMINER O'HARA, EILEEN B	
			ART UNIT 1646	PAPER NUMBER

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,086

Applicant(s)

ASHKENAZI ET AL.

Examiner

Eileen O'Hara

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63, 66, 68-70 and 74-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63, 66, 68-70 and 74-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The finality of the last office action is withdrawn due to a new rejection under 35 USC § 102.

Claim Status

2. Claims 63, 66, 68-70 and 74-84 are pending in the instant application. Claim 78 has been amended as requested by Applicant in the Paper filed April 22, 2005.

Withdrawn Objections and Rejections

3. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

Claim Objections

4. Claim 78 is objected to because of the following informalities: on line 2 of the claim, "nucleotides" should be the singular "nucleotide" to be grammatically correct. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 63, 66, 68-70 and 74-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5.1 Claims 63, 66, 68-70 and 74-77 are indefinite because in claim 63, part (c), there is no SEQ ID number recited.

5.2 Claims 78-84 are indefinite because in claim 78 in the preamble, it is not clear whether the complement (on second line) refers to the complement of the fragment or the entire sequence of SEQ ID NO: 6.

Priority Determination

35 U.S.C. § 119(e) states that:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

6. Applicant is advised that the instant application can only receive benefit under 35 U.S.C. § 120 or § 119(e) from an earlier application which meets the requirements of 35 U.S.C. § 112, first paragraph, with respect to the now claimed invention. The utility of the polynucleotide of SEQ ID NO: 6 is that it is amplified in lung tumors. However, prior applications 60/082,700, PCT/US99/05028 and 09/380,138 do not disclose that the polynucleotide is amplified in lung tumors, and those applications do not support either a specific and substantial utility or a well established utility for the polynucleotide, and are therefore unavailable under 35 U.S.C. § 120 or § 119(e). Since the instant application claims priority to PCT/US00/03565 and that application disclosed that the nucleic acid of SEQ ID NO: 6 was amplified in lung tumors, the instant application has an effective priority date of Feb. 11, 2000, the filing date of that PCT.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 78-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Komatsoulis et al., U.S. Patent No. 6,476,195, filing date Jan. 24, 2000.

Claims 78-84 encompass nucleic acid molecules consisting of fragments of the nucleic acid of SEQ ID NO: 6, wherein the fragments consist of at least 20, 50, 60, 70, 80, 90 or 100 nucleotides.

Komatsoulis et al. disclose a nucleic acid molecule that is 99.8% identical to nucleotides 595-2943 of SEQ ID NO: 6, and comprise regions greater than 100 contiguous nucleotides.

Komatsoulis et al. also teaches that fragments of the nucleic acid can be made that would be useful as probes or primers (column 2, lines 54-62, column 186, line 44 to column 187, line 23).

Therefore, Komatsoulis et al. anticipates the claims.

Conclusion

8. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878.

The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (571) 272-0829.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner



EILEEN B. O'HARA
PATENT EXAMINER